

REMARKS

Claims 1-15 and 17-20 are pending in the Subject Application. In the Final Office Action of January 26, 2009, claims 15, 17-18 and 20 have been deemed allowable, while claims 1, 2, 4-14 and 19 stand rejected. Claims 1 and 10 have been amended to recite, "wherein the liquid substance comprises a retained portion of the rinse solution" and find support throughout the specification, such as page 3, paragraph 3. Claim 3 has been canceled. Claim 16 was previously canceled. Applicant submits that no new matter has been introduced by way of the amendment to the claims.

A. Objection of Claim 3

Claim 3 has been objected to as being dependent upon a rejected base claim. The Examiner asserts that claim 3 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Applicant submits that claim 3 has been canceled and that the limitation from claim 3 has been incorporated into claim 1. Amended claim 1 recites, "[a] method for cleaning and sterilizing a medical device comprising: placing the device into a container, cleaning the device in the container with a cleaning solution; rinsing the device in the container with a rinse solution; vaporizing a liquid substance in the container to create a sterilant vapor, wherein the liquid substance comprises a retained portion of the rinse solution; and contacting the device with the vapor to effect sterilization of the device".

Hence Applicant respectfully submits that the objection to claim 3 is obviated and requests that the objection be withdrawn.

B. Rejection of Claims 1 and 4-9 under 35 U.S.C. §103(a)

Claims 1 and 4-9 are rejected under 35 U.S.C. §103(a) as assertedly being unpatentable over U.S. Patent No. 5,961,921 to Addy et al. (hereinafter "Addy") in view of U.S. Patent No. 5,653,045 to Ferrel (hereinafter, "Ferrel"). Applicant traverses this rejection for at least the reasons set forth herein.

As set forth in *Section A*, Applicant submits that claim 3 has been canceled and that the limitation from claim 3 has been incorporated into claim 1. The Examiner has deemed claim 3 allowable if written in independent form. Thus, claim 1 has been written in this manner. Claims 4-9 depend from claim 1 and are, therefore, allowable.

Accordingly, withdrawal of the rejection to claims 1 and 4-9 is respectfully requested.

C. Rejection of Claims 10-14 and 19 under 35 U.S.C. §103(a)

Claims 10-14 and 19 are rejected under 35 U.S.C. §103(a) as assertedly being unpatentable over Addy in view of Ferrel. Applicant traverses this rejection for at least the reasons set forth herein.

For at least the reasons set forth in *Section A*, claims 10-14 and 19 are allowable and allowance of claims 10-14 and 19 is respectfully requested.

D. Nonstatutory Double Patenting Rejections

Claims 1-15 and 17-20 stand rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-19 of copending Application No. 11/024,118 (hereinafter "the 118' patent"). For the reasons already of record, it is submitted that the claims, as amended, are clearly distinguished from the '118 patent. However, in order to expedite prosecution of this matter, Applicant

hereby submits a terminal disclaimer in accordance with 37 C.F.R. § 1.321(c), signed by Sean M. Conrad, Patent Agent of record, empowered to act on behalf of the assignee, Ethicon Inc. Applicant also submits that the terminal disclaimer fee under 37 C.F.R. 1.20(d) may be charged to Account No. 11-1110.

The filing of this terminal disclaimer to obviate the rejection based upon nonstatutory double patenting is not an admission of the propriety of the rejection. Indeed, Applicant disagrees that claims 1-15 and 17-20 are not patentably distinct from claims 1-19 of '118 patent. The filing of this terminal disclaimer simply serves the function of removing the double patenting rejection to expedite prosecution, and raises neither a presumption nor an estoppel on the merits of the rejection. In addition, this terminal disclaimer filed to obviate this double patenting rejection is effective only with respect to the applications identified in the disclaimer.

Accordingly, withdrawal of the rejection under the judicially created doctrine of double patenting is respectfully requested.

E. Status of Related Applications

Related U.S. Patent Application No. 11/024,118 is under Non-Final rejection mailed December 19, 2008.

CONCLUSION

Applicant respectfully submits that claims 1-15 and 17-20 recite novel and non-obvious methods for cleaning and sterilizing a medical device. Applicant submits that these claims define over the prior art of record and are in proper form for allowance. In view of the foregoing, Applicant respectfully submits that

the Subject Application is in condition for allowance. Accordingly, reconsideration of the rejections to claims 1-15 and 17-20 at an early date are earnestly solicited.

Applicant does not otherwise concede, however, the correctness of the rejections with respect to any of the dependent claims not discussed above. Accordingly, Applicant hereby reserves the right to make additional arguments as may be necessary to further distinguish the dependent claims from the cited references based on additional features contained in the dependent claims that were not discussed above. A detailed discussion of these differences is believed to be unnecessary at this time in view of the differences in the claims pointed out above.

If the undersigned can be of assistance to the Examiner regarding any of the above, please contact the undersigned at the number set forth below. Applicant submits that if any additional fee is necessary for consideration of this Response, the Commissioner is hereby authorized to charge the additional required fees to Account No. 11-1110.

Respectfully submitted,

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Date

Sean M. Conrad
Sean M. Conrad
Patent Agent
Registration No. 61,532

K&L GATES LLP
Henry W. Oliver Building
535 Smithfield Street
Pittsburgh, Pennsylvania 15222
Telephone: (412) 355-6218
Facsimile: (412) 355-6501

Customer No.: 26,285